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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/784,258      | 02/24/2004  | Mitsushige Murata    | 02910.000119        | 1242             |

5514 7590 12/21/2006  
FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

| EXAMINER |
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NICHOLSON III, LESLIE AUGUST

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3651

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE  | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS                               | 12/21/2006 | PAPER         |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

|                              |  |                                      |  |
|------------------------------|--|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/784,258       | <b>Applicant(s)</b><br>MURATA ET AL. |  |
|                              | <b>Examiner</b><br>Leslie A. Nicholson III | <b>Art Unit</b><br>3651              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/31/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The applicant appears to be attempting to use means plus function (see at least lines 4,9,12 of claim 1, for example). Does the applicant intend to invoke 35 USC 112 6<sup>th</sup> paragraph? The examiner has construed this claim as to not invoking 35 USC 112 6<sup>th</sup> paragraph. See MPEP 2114 and 2181.

Regarding claim 1,11,13,20, the claims each recite a condition of operation by using the language "wherein, when the rear end of the sheet". A condition of operation does not further structurally limit the device.

Furthermore, each of the independent claims recite conveyance means. The wording of the recitation renders the claims unclear. Are the conveyance means supported by the support means? Or is the sheet or sheet bundle supported by the support means? Or both?

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Asao  
USP 6,120,020.

Regarding claims 1-12, Asao discloses a sheet handling apparatus comprising:

- Sheet stack means (16)
- Support means (46)
- Change-over control means including detection means (52) (C5/L14-21)
- Conveyance means (18a)
- Handling means including a handling tray (12), aligning means (28), and staple means (60) (fig.2)
- A sheet returning member (49a) (fig.4)
- Image forming means (40) (fig.1)

Regarding claims 13-21,

- First support means (18a)
- Second support means (46)

- Conveyance means (18b)

5. Claims 1,2,5-14,17-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawano USP 5,741,009.

Regarding claims 1,2,5-12, Kawano discloses a sheet handling apparatus comprising:

- Sheet stack means (T1)
- Support means (414)
- Change-over control means including detection means (S4)
- Conveyance means (404)
- A sheet returning member (405) (fig.11)
- Image forming means (fig.1)

Regarding claims 13,14,17-21,

- First support means (413)
- Second support means (414) (fig.4)
- Conveyance means (414)

6. Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Kato PGPub 2003/0214090.

Regarding claims 1-12, Kato discloses a sheet handling apparatus comprising:

- Sheet stack means (4)
- Support means (70)

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- Change-over control means including detection means (52) (C5/L14-21)
- Conveyance means (71)
- Handling means including a handling tray (40), aligning means (41,42), and staple means (10)
- A sheet returning member (4a)
- Image forming means (40) (fig.1)

Regarding claims 13-21,

- First support means (50)
- Second support means (70)
- Conveyance means (71)

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie A. Nicholson III whose telephone number is 571-272-5487. The examiner can normally be reached on M-F, 8:30 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on 571-272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

L.N.  
11/15/2006

  
GENE O. CRAWFORD  
SUPERVISORY PATENT EXAMINER